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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,636	04/09/2004	Scott E. Williams	005127.00226	9029

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EXAMINER

HANEY, RICHAE LEE

ART UNIT PAPER NUMBER

3765

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/821,636	WILLIAMS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Richale L. Haney	3765	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/15/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the instructions permanently secured to the interior of the garment must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 – 4, 6, 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Buonassissi (US 4,601,067). The device of Buonassissi discloses a apparel article, specifically a vest, for moderating body temperature (10), comprising a torso region (12, 14, 16) having a chest region and a back region, and a pair of side regions (24, 30), shoulder regions (Figure 1), a plurality of cavities on the front, back and side regions (36, 34), at least a portion of the shoulder region (32), and a fitting system (20, 22, 28, 26) extending at least partially around the torso region and having a substantially vertical direction through the chest area (20, 22). It is noted by the examiner that the fastening system (28, 26) is adjustable to that the sides (24, 30) may be in direct contact with each other). Thermal inserts, comprising water (Column 2, lines 19 –21) are inserted into the pockets (32, 34, 36).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bounassissi in view of Steele et al. (US 5,146,625). The device of Bounassissi substantially discloses the claimed invention but is lacking an insert having multiple chambers. The device of Steele et al. discloses a thermal insert for a vest having multiple chambers within (52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Bounassissi by incorporating multiple chambers as taught by Steele et al. in order to allow easier use of flexing (Column 4, lines 43 – 45).

7. Claims 8 – 15, 17 – 25, 27 – 30, 34 – 43, and 45 – 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buonassissi in view of The Federal Trade Commissions Rules. The device of Buonassissi substantially discloses the claimed invention but is lacking pictorial instructions that are permanently secured to the interior of the garment. According to the Care Labeling Rule, care instructions must be permanently secured to the inside of textile wearing apparel. Effective, July 1, 1997 the Federal Trade Commission permits the use of symbols, in place of written instructions, to provide instruction as to the method of cleaning. Care symbols developed by the

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American Society of Testing and Materials (ASTM) show pictorial representation for utilizing the garment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to permanently secure pictorial instructions to the textile apparel garment of Buonassissi, since it is a federally mandated regulation. In regard to the instructions, the limitations specifying how the garment is used is functional. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

8. Claims 31 – 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bounassissi. Bounassissi does not state the method using the vest, but it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the device in the manner claimed. The structure of the device is fully capable of being used in the method recited by the applicant and is therefore determined to meet the limitations as claimed.

9. Claims 16, 26 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bounassissi and The Federal Trade Commission as applied to claims 8 – 15, 17 – 25, 27 – 30, 34 – 43, and 45 – 48 above, and further in view of Steele et al. (US 5,146,625). The modified device of Bounassissi substantially discloses the claimed invention but is lacking an insert having multiple chambers. The device of Steele et al. discloses a thermal insert for a vest having multiple chambers within (52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to

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further modify the device of Bounassissi by incorporating multiple chambers as taught by Steele et al. in order to allow easier use of flexing (Column 4, lines 43 – 45).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

St. Ours (US 5,072,455) discloses a vest having thermal inserts and a fitting system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richale L. Haney whose telephone number is 571-272-8689. The examiner can normally be reached on M-F 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on 571-272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Richale L. Haney  
Patent Examiner  
Art Unit 3765  
August 28, 2006

RLH



**GARY L. WELCH**  
**PRIMARY EXAMINER**